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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,830	12/30/1999	RICHARD NORRIS DODGE II	11710-0111	6932

23594 7590 08/12/2003

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EXAMINER
PRATT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
1771	17

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-17

Office Action Summary	Application No.	Applicant(s)	
	09/475,830	DODGE II ET AL.	
	Examiner	Art Unit	
	Christopher C Pratt	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23 and 31-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23 and 31-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and accompanying remarks filed 6/2/03 have been entered and carefully considered. Applicant's amendment and arguments are found to overcome the 112 indefinite rejection over Ex parte Slob because the specification provides sufficient structure to compensate for the lack of description in the claims. Despite this advance, the amendments are not found to patently distinguish the claims over the prior art and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Claim Rejections - 35 USC § 112

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-23 and 31-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, as set forth in the previous action. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention. As previously set forth, applicant's specification does not teach the skilled artisan how to achieve the claimed permeability properties. Applicant argues that pages 29-34 of the specification disclose at least one method for making the claimed invention that bears a reasonable correlation to the entire scope of the claims. Applicant argues that these pages clearly provide for the preparation of the absorbent

structures. These pages only teach that known superabsorbent can be "combined" with fibers and "formed into webs using conventional air-forming equipment (p. 31)." The specification does not teach how to "combine" the superabsorbent with the fibers and does not specify what "conventional air-forming equipment" should be used. Moreover, applicant's specification seems to only suggest combining known superabsorbent with known fibers and does not teach the skilled artisan how to achieve applicant's claimed properties.

4. Claims 1-23 and 31-39 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention, as set forth in the previous action. Evidence that claim 1-23 and 31-39 fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 14 filed 11/26/02. In that paper applicant put forth an argument that was used as evidence for this rejection. Applicant does not retract the statement nor does applicant argue that the statement was incorrect. Applicant argues that the examiner misinterpreted the statement because it was not read in its entirety. Applicant argues that the phrase "that provide a high composite permeability with a lower capacity" changes the scope of the statement.

It is the examiner's position that this additional phrase does not change the scope of the statement. This phrase only modifies the type of fiber used in the invention. The statement is still interpreted by the examiner to mean that the

invention only comprises superabsorbent and fibers and, therefore, it contradicts the open transitional language of the claims.

Claim Rejections - 35 USC § 103

5. Claims 1-23 and 31-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman (6380465 and 5669894), Chen et al (6261679), Beihoffer et al (6235965), Makaida et al (5676660), as set forth in the previous two actions.

Applicant argues that Goldman '894 fails to teach applicant's claimed properties because Goldman teaches a higher AUL value. However, Goldman teaches the exact same polymer used by applicant and the exact same fibrous structure. Therefore, it is the examiner's position that the resulting properties are equivalent. The examiner notes that applicant has not pointed out why the materials used in the instant invention would have different properties from the same materials used by Goldman.

Applicant argues that "the present invention provides absorbent structures that are unconventional to known or available absorbent composites, such as the Goldman absorbent members." However, applicant's specification teaches that applicant's claimed properties can be achieved using "conventional" equipment (p. 31, lines 10-15).

Applicant argues that Goldman's lower limit of AUL values is approximately 25.5 at .6psi while the upper limit of applicant's claimed AUL is 25 at .6psi. However, both applicant and Goldman include the term "about"

preceding the AUL values, which extends the ranges in either direction. Therefore, it is the examiner's position that the properties of Goldman overlap with applicant's claimed properties.

Applicant argues that Goldman '456 fails to teach the instant invention because Goldman teaches a combination of superabsorbent polymers. This argument is not commensurate in scope with applicant's claims. The claims utilize the open transitional language "consisting essentially of," which allows for the incorporation of other materials, that do not materially effect the basic and novel characteristics of the invention (MPEP 2111.03). It is the examiner's position that the combination of polyems does not materially effect the basic and novel characteristics of the invention. The examiner notes that applicant actually claims a "mixture" of superabsorbent polymers.

With respect to Chen, Applicant dismisses Chen's teaching to utilize superabsorbent materials as a "brief reference" and argues that Chen's superabsorbent materials do not have applicant's claimed AUL. However, applicant concedes that Chen teaches a superabsorbent polymer having an AUL of 6 at .3 psi. According to applicant's calculation, this is equivalent to an AUL of approximately 13.5 at .6psi, which is well within applicant's claimed range.

With respect to Beihoffer, applicant argues that Beihoffer fails to teach applicant's invention because it teaches a combination of superabsorbent polymers. This argument is not commensurate in scope with applicant's claims. The claims utilize the open transitional language "consisting essentially of," which allows for the incorporation of other materials, that do not materially effect the

basic and novel characteristics of the invention (MPEP 2111.03). It is the examiner's position that the combination of polyems does not materially effect the basic and novel characteristics of the invention. The examiner notes that applicant actually claims a "mixture" of superabsorbent polymers.

With respect to Mukaida, applicant argues that the claimed AUL is not taught. Applicant disregards the broad teaching in col. 3, which states that AUL values within applicant's claimed range are acceptable, and relies on Mukaida's specific examples. This argument is not persuasive because references are evaluated by their entire teachings and not by specific examples or preferred embodiments.

Applicant argues that Mukaida fails to teach applicant's claimed permeability property. Applicant supports this argument by stating that Mukaida's low intake rates "are indicative of absorbent products that comprise low permeability components." This argument is not persuasive because Applicant offers no evidence of a direct relationship between intake rates and the instantly claimed permeability property. Moreover, applicant is observing only the intake rates of one specific example and is not evaluating the entire teachings of Makaida.

Applicant describes the results of a comparison of the instant invention and a commercial superabsorbent product that is "similar" to the invention of Makaida. These results and the arguments flowing therefrom are not given weight because they do actually compare the invention of Makaida with the instant invention and thus any conclusions based on this comparison are not

applicable to the instant rejection. Said rejection is maintained from the last action.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher C. Pratt
August 10, 2003

CHERYL A. JUSKA
PRIMARY EXAMINER